REMARKS

I. INTRODUCTION

With the addition of claims 18 to 20, claims 1 to 20 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. REJECTION OF CLAIMS 16 and 17 UNDER 35 U.S.C. § 102(b)

Claims 16 and 17 were rejected under 35 U.S.C.§ 102(b) as anticipated by U.S. Patent No. 4,427,205 ("Hoelzer et al."). It is respectfully submitted that Hoelzer et al. do not anticipate claims 16 and 17, as amended herein, for the following reasons.

Claim 16, from which claim 17 depends, relates to a sealing arrangement for forming a seal around a machine element. Claim 16 has been amended to recite that the sealing arrangement includes a sealing ring operable to permit flow between an area to be sealed off and a surrounding area, via at least one recess extending in the sealing ring and having a depth in a radial direction between a side of the sealing ring facing radially away from the machine element and a side facing the machine element, if the sealing ring is incorrectly mounted on the machine element. Support for this amendment can be found, for example, at page 4, line 29 to page 5, line 18.

Hoelzer et al. purportedly relate to a radial shaft sealing ring. See Abstract. Referring to Figure 1 of Hoelzer et al., the washer-like sealing element 2 is curved forward to one side in the direction toward the sealed-off medium and is expanded in the radial direction. The sealing element 2 is stated to contact the sealed-off shaft 3 only in the region of the contact area A. See col. 4, lines 3 to 8. The contact area of the sealing element and the areas of the sealing element adjacent both sides of the contact area in the axial direction are stated to be made with smooth surfaces and merge steadily with each other with a curvature. See col. 4, lines 11 to 15. In one embodiment, the base area 4 is stated to be broken by a multiplicity of swirl fins 5. See col. 4, lines

30 to 33. The swirl fins are stated to have a negative inclination. See col. 4, lines 43 to 44. Nowhere do Hoelzer et al. disclose, or even suggest, a sealing arrangement including a sealing ring operable to permit flow between an area to be sealed off and a surrounding area, via at least one recess extending in the sealing ring and having a depth in a radial direction between a side of the sealing ring facing radially away from the machine element and a side facing the machine element, if the sealing ring is incorrectly mounted on the machine element, as recited in amended claim 16. The Office Action admits to this deficiency of Hoelzer et al. at p. 3 of the Office Action. Therefore, Hoelzer et al. do not disclose all of the limitations of claim 16.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Hoelzer et al. do not disclose, or even suggest, a sealing arrangement including a sealing ring operable to permit flow between an area to be sealed off and a surrounding area, via at least one recess extending in the sealing ring and having a depth in a radial direction between a side of the sealing ring facing radially away from the machine element and a side facing the machine element, if the sealing ring is incorrectly mounted on the machine element, as recited in claim 16. Therefore, it is respectfully submitted that Hoelzer et al. do not anticipate amended claim 16.

Additionally, to reject a claim under 35 U.S.C. § 102, the Examiner must demonstrate that each and every claim limitation is contained in a single prior art reference. *See,*

Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Still further, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. *See, Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In particular, it is respectfully submitted that, at least for the reasons discussed above, the reference relied upon would not enable a person having ordinary skill in the art to practice the inventions of the rejected claims, as discussed above.

The Office Action alleges that if "the seal was to be inserted erroneously in the opposite direction the contact area A would fail to seal the shaft." See Office Action at p. 2. However, Hoelzer et al. do not indicate the geometry of the sealing lip (4) in this incorrect position. It is possible that, given its stated radial flexible polymer make-up, sealing lip (4) conforms to the shaft (3) in such a manner as to prevent flow between the sealed-off area and the surrounding area. See col. 1, line 55 and col. 2, line 19. To the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." See M.P.E.P. § 2112 (emphasis in original); and see, *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, the anticipation rejection as to the rejected claims must necessarily fail for the foregoing reasons.

Notwithstanding the above, claim 16 has been amended to recite a recess, in contrast to the waves or convolutions of Hoelzer et al., which is actually in the sealing ring, i.e., it has a depth which extends radially from a surface facing the

surrounding area to a point between said surface and a surface facing the machine element. As indicated above, nowhere do Hoelzer et al. disclose, or even suggest, a sealing ring having at least one recess extending in the sealing ring and having a depth in a radial direction between a side facing radially away from the machine element and a side facing the machining element, as recited in amended claim 16. Therefore, Hoelzer et al. do not disclose, or even suggest, all of the limitations of amended claims 16. Applicant submits, therefore, that claim 16 is patentable over Hoelzer et al. Accordingly, withdrawal of the 35 U.S.C. § 102(b) rejection and allowance of claim 16 is respectfully requested.

As for claim 17, which depends from claim 16 and therefore includes all of the limitations of claim 16, it is respectfully submitted that Hoelzer et al. do not anticipate this dependent claim for at least the same reasons provided above in support of the patentability of amended claim 16. Therefore, withdrawal of the 35 U.S.C. § 102(b) rejection and allowance of claim 17 is respectfully requested.

III. Allowed Claims 1 to 15

Applicant hereby acknowledges and thanks the Examiner for the allowance of claims 1 to 15.

IV. New Claims 18 to 20

New claims 18 to 20 have been added herein. It is respectfully submitted that new claims 18 to 20 do not add any new matter and are fully supported by the present application, including the Specification. Because claims 18 to 20 contain features analogous to claim 1, 10 and 16 it is respectfully submitted that claims 18 to 20 are allowable for at least the same reasons submitted above and previously submitted in support of the patentability of claims 1, 10 and 16. Further, the distal end of the sealing ring in Hoelzer et al. is shown as curling up and away from the machine element. See Figures 1 to 3 and col. 4, lines 3 to 9.

V. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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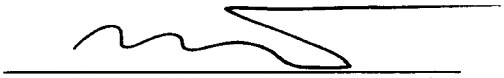

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